

REMARKS

Applicant has studied the Office Action dated February 16, 2006, and has amended claims 20-22 and 25 and canceled claims 23, 24 and 29 without prejudice. Claims 20-22, 25-28 and 30-32 are pending. Claims 20 and 30-32 are independent claims. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Amendments to the Claims

Claims 20-22 and 25 have been amended to correct typographical errors. It is respectfully submitted that the amendments have support in the application as originally filed and are not related to patentability.

§ 112 Rejections

The Examiner rejected claims 23, 24 and 29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserted that the claims recite subject matter not supported in the original disclosure of the specification.

With this paper, claims 23, 24 and 29 have been canceled without prejudice. It is, therefore, respectfully submitted that the rejection is moot and it is respectfully requested that the rejection be withdrawn.

§ 102 Rejections

Claims 20, 21, 25-27 and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Takahashi et al. ("Takahashi" U.S. Patent No. 6,483,983). Applicant respectfully disagrees with the Examiner's interpretation of Takahashi and traverses the rejection.

It is respectfully noted that a proper rejection for anticipation under § 102 requires complete identity of invention. The claimed invention, including each element thereof as

recited in the claims, must be disclosed or embodied, either expressly or inherently, in a single reference. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991); Standard Havens Prods., Inc. v. Gencor Indus., Inc., 953 F.2d 1360, 1369, 21 U.S.P.Q.2d 1321, 1328 (Fed. Cir. 1991).

It is respectfully noted that independent claims 20 and 30-32 recite storing thumbnail pictures in a menu data area of a recording medium. As illustrated in FIG. 6 of the specification as originally filed, actual thumbnail pictures are stored in the recording medium as a block of data. On the other hand, it is respectfully submitted that Takahashi fails to disclose storing thumbnail pictures in a menu data area of a recording medium.

It is respectfully noted that Takahashi is directed to a "method and apparatus for recording picture information on a recording medium." Col. 1, ll. 9-17. As such, it is respectfully submitted that the disclosure contained in Takahashi is directed to the apparatus that records the information rather than to the "recording medium" on which the information is recorded.

It is further respectfully noted that Takahashi discloses a "function for diminishing or reducing the size of picture for display upon decoding of the picture signal. Col. 4, ll. 34-37. Therefore, it is respectfully submitted that Takahashi discloses the reduction of non-thumbnail "picture data" stored on a recording medium such that the "reduced screen picture data" may be displayed rather than storing "reduced screen picture data," or thumbnail pictures, on a recording medium, as evidenced by the process disclosed at Col. 6, ll. 1-51 and steps S45-S47 of FIG. 4 during which the "driver unit 1 starts reproduction of the information... of the disk" and the "decoder unit 3 reduces the picture represented by the reproduced signal" in order to "place the corresponding reduced screen picture data in the display-destined picture storage area 401."

Moreover, it is respectfully noted that the only storage of "reduced screen picture data," or thumbnail pictures, disclosed in Takahashi is in a "display-destined picture storage area 401" that is part of the "RAM 4" of the "reproducing apparatus." Col. 4, ll. 51-55, col. 6, ll. 43-46, FIG.1 and step S47 of FIG. 4. Therefore, it is respectfully

submitted that Takahashi discloses storing "reduced screen picture data," or thumbnail pictures, in the "reproducing apparatus" as opposed to in the recording medium.

Therefore, it is respectfully asserted that independent claims 20 and 30-32 are allowable over the cited reference. It is further respectfully asserted that claims 21 and 25-27, which depend from claim 20, also are allowable over the cited reference.

§ 103 Rejections

Claims 22 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takahashi in view of Chen et al. ("Chen" U.S. Pat. No. 5,917,830). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully submitted that Chen fails to cure the deficiencies of Takahashi with respect to storing thumbnail pictures in a menu data area of a recording medium, as recited in independent claim 20. Therefore, it is respectfully asserted that independent claim 20 is allowable over the cited combination of references, as are claims 22 and 28, which depend from claim 20.

CONCLUSION

In light of the above remarks, Applicant submits that the claims 20-22, 25-28 and 30-32 of present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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